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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/658,879	09/08/2000	Toshihiko Oda	S0255.0004/P004	2562

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EXAMINER

PRIETO, BEATRIZ

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 10/01/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/658,879 J

Applicant(s)

ODA, TOSHIHIKO

Examiner

B. Prieto

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2000. ✓
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final. J
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application. J
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected. J
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- ✓ 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). ✓
- ✓ a) ☒ All b) ☐ Some * c) ☐ None of:
- ✓ 1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) ✓
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This communication is in response to Application No. 09/658,879 filed 09/08/00, claims 1-18 remain pending and hereby are set forth for examination.

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). Certified copy has been received of Application No. 11-255097, filed on 09/09/99 in Japan.

3. Drawings filed 09/08/00 have been reviewed and approved by Draftsman person.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claims 2, 8, and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "most highly capable categories among the profiles" on claims 2, 8 and 14 is a relative clause that renders the claim indefinite. The phrase "most highly capable categories" is not defined by the claim, the specification does not provide a specific or standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention.

In this case, the phrase broadly speaking refers to features, functions or capabilities associated with (devices) printers. Specifically, according applicant's disclosure a "most highly capable capability" seems to refer to the device's available features, functions or capabilities to be selected by a user, (see disclosure page 11, lines 3 to page 12, line 24, page 13, lines 9-15, page 25, lines 24-25). For the purposes of examination, the former broadest interpretation will be applied to the claim language in light of the specification (see MPEP § 2111).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over ROY et. al (Roy) U.S. Patent No. 6,496,859 B2 in view of OWA et. al. (Owa) U.S. Patent No. 6,348,971 B2.

Regarding claim 1, Roy teaches a system/method usable for selecting a device from a number of devices connected to a network, said apparatus comprising:

- a detecting unit which detects all the devices (35) connected to said network (45) (Roy: col 3/lines 27-37: finding (detecting) all devices connected to the network);

- an extracting unit which extracts profiles comprising information for the use of said devices (Roy: parsing functions which extract ("profiles") information (65) relating to the functions or capabilities ("categories") of said devices, col 2/lines 31-38, 52-57, extract information: col 4/lines 3-12, obtain profile data (65), col 3/lines 51-59 and col 5/lines 35-37);

- a table creating unit which creates a table containing information for the use of the devices (Roy: generated an arrangement or listing ("table") containing device information relating to the categories of said devices, including listing of devices, col 5/lines 55-col 6/line 6);

- an integrated profile creating unit which creates an integrated profile comprising information obtained by integrating the profiles of said devices (Roy: creating a collection of information ("integrated profile") obtained by combining or adding the information ("profiles") of said devices, col 5/lines 42-col 6/line 9);

- a user interface creating unit which creates a user interface enabling necessary categories to be selected from the categories which comprise the integrated profile created by said integrated profile creating unit (Roy: a browser or web-PC for creating a user interface enabling available functions or capabilities ("categories") to be selected from the collection of information about connected devices ("integrated profile") col 1/lines 15-23); although prior art teaches creating a table containing a listing of said devices used by the user for selecting a device from among said devices;

Roy does not teach where the table contains a predetermined arrangement ("priority rankings") for the use of said devices, for selecting a device from among said devices based selected categories and the table containing the priority rankings;

Owa teaches a system/method related to the selection of the most appropriate device for use by a user (see abstract, col 1/lines 8-12, and col 2/lines 1-6) including,

- priority ranking devices for selecting a device to be used among the ranked devices,

wherein an selection means (11 of Fig. 2), selects a device from among other devices (see Figs. 34) by selecting a device having the highest final score as the optimum device printer from among the printers based on a predetermined ranking criterion, such as the printer name order, ascending order of the number of printer operation times, identification number order, or preset priority (i.e. "priority ranking") (see col 6/lines 66-col 7/line 11);

It would have been obvious to one ordinary skilled in the art at the time the invention was made given Roy's suggestion of discovering profiles comprising information relating to the functions or capabilities (categories) of multiple devices having multiple categories, to utilize Owa's teachings for enabling a user select an optimum device from among said devices having multiple categories, including selecting a device based on the user selected categories and the priority ranking of said devices, further enabling the generation of a table which contains a predetermined arrangement ("priority rankings") and categories for the use of said devices for selecting a device from among the said devices based the user selected categories and the table containing the priority rankings. Motivation would be to enhance Roy's system by preventing the user from devoting a lot of time and effort in checking a large number of devices for a desired specification and performance to select a device providing all the selected required functions, as suggest by Owa.

Regarding claim 2, creating the integrated profile by integrating the most highly capable categories among the profiles of said devices (Roy: aggregating or combining ("integrating") the ("most highly capable categories") available functions among the information ("profiles") of said devices, col 5/lines 42-col 6/line 9).

Regarding claim 3, a user interface which displays information relating to the categories comprising the integrated profile for a user's selection ("with respect to a user") on a display screen and enables the user to select necessary categories from the categories displayed on said display screen (Owa: user enters printer features as desired print conditions: col 4/lines 18-33, user specifies categories: col 5/lines 17-25, 30-31 setting desired print conditions on a GUI and Roy: user display of Fig. 7, including the integrated profile for a user's selection on a display screen).

Regarding claim 4, a memory unit which stores the profiles extracted by said extracting unit (Roy: store device information: col 3/lines 5-59),

said selecting unit has used ("consulted") the stored profiles and determined that there is no

device comprising all the categories which have been selected via the user interface, said selecting unit selects said device from among said devices which comprises a part of the selected categories (Owa: i.e. given the stored profiles (device information), the categories (device function or capabilities) selected by the user and a predetermined priority, if no device comprises all the categories the device satisfying as much desirable conditions as possible is selected, col 5/lines 18-25).

Regarding claim 5, when a new category has been selected via said user interface after said device has been selected, said selecting unit reselects said device by including the category which has been selected this time by priority in said part of the categories (Owa: i.e. selection of categories by priority enable the selection of device that satisfies selected category (or new category) when the device contains the features that is satisfies all required categories selected by the user according to a specified priority, e.g. priority B such as conditions that should preferable (most of or in part) be met, col 5/lines 1-25).

Regarding claim 6, wherein said devices are printers (35) (Roy: abstract, col 3/lines 27-37).

Regarding claim 7, this claim method includes limitation substantially the same as those discussed on claim 1, same rationale of rejection is applicable, limitations further include,

providing before hand a table containing an integrated profile, comprising information obtained by integrating profiles comprising information relating to categories of said devices connected to said network and priority rankings for the use of said devices; (Roy: i.e. providing a listing or arrangement (table) for user selection (beforehand selecting) containing aggregated features or functions of said devices, col 5/lines 55-col 6/line 6, col 5/lines 42-col 6/line 9, Owa: priority ranking devices for selecting a device to be used among the ranked devices, listing or arrangement (priority ranked) of the printer devices in name order, ascending order of the number of printer operation times, identification number order, or preset priority col 6/lines 66-col 7/line 11).

Regarding claims 8-12, these claims are substantially the same as claims 2-6, respectively, same rationale of rejection is applicable.

Regarding claim 13, this claim comprises the computer readable medium for storing instructions, which when executed by a computer, causes the computer to perform the functions discussed on

apparatus claim 1, same rationale of rejection is applicable to the computer product claim.

Regarding claims 14-18, these claims comprises the apparatus or software implementation, i.e. computer readable medium for storing instructions, which when executed by a computer, causes the computer to perform the functions discussed on apparatus claims 2-6, respectively, same rationale of rejection is applicable to the computer product claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (703) 305-0750. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Mark R. Powell can be reached on (703) 305-9703. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-6606. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or Central Fax Office: (703) 872-9306

Or Telephone: (703) 306-5631 for TC 2100 Customer Service Office.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, Fourth Floor (Receptionist), further ensuring that a receipt is provided stamped "TC 2100".



B. Prieto
TC 2100
Patent Examiner
September 2, 2003